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Room 3J-219
101 Crawfords Corner Rd.
Holmdel, NJ 07733-3030

In re Application of :
RUPAREL, Ketan :
U.S. Application No.: 10/069,685 :
PCT No.: PCT/EP00/05709 :
Int. Filing Date: 20 June 2000 :
Priority Date: 31 August 1999 :
Attorney's Docket No.: Ruparel - 1 :
For: METHOD AND APPARATUS FOR :
ESTABLISHING COMMUNICATION :

DECISION

The decision is in response to the papers submitted on 27 August 2002.

BACKGROUND

On 20 May 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required. Applicant was given two-months to respond with extensions of time available pursuant to 37 CFR 1.136(a).

On 27 August 2002, applicant submitted the instant petition ("Pet.") which was accompanied by, *inter alia*, a one-month extension and fee; a document titled "Verified Statement of Facts Under 37 C.F.R. 1.47" signed by Valerie Barnes ("Decl."); and an unexecuted declaration.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the requisite petition fee, (2) factual proof that the inventors cannot be reached after diligent effort, (3) a statement of the last known address of the inventors, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventors, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the

application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

The appropriate petition and extension fees have been charged to Deposit Account No. 12-2325 as authorized. The last known address of the sole inventor, Ketan Ruparel is:

12 Winsdon Road
Luton, Bedfordshire LU1 5JT
United Kingdom

With regard to item (6), section 409.03(g) of the Manual of Patent Examining Procedure (MPEP) Eighth Edition, states that "[i]rreparable damage may be established by a showing (a statement) that a filing date is necessary to preserve the rights of the party or to prevent irreparable damage." Counsel states that "such action is necessary to preserve the intellectual property rights of Lucent and to prevent abandonment of the subject application for failure to respond to the Notification of Missing Requirements Under 35 U.S.C. 371." Pet. at ¶ 4.

Therefore, items (1), (3) and (6) of 37 CFR 1.47(b) are satisfied.

But to meet item (2), petitioner claims that the sole inventor "cannot be reached." Pet. at ¶ 1. Section 409.03(d) of the MPEP discusses the requirements to show that an inventor cannot be reached and states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. **Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement.** (Emphasis added).

In this case, applicant has not provided all of the required documentary evidence such as a copy of the letter and other documents mailed 15 November 2001 to Mr. Ruparel at his home address, Decl. at ¶ 3, a copy of the E-mail sent from Lucent Technologies Human Resources department to Ms. Barnes, Id. at ¶ 4, and any evidence from internet searches. Id. at ¶ 5. For this reason, item (2) is not satisfied.

It is also noted that if the sole inventor is located, a complete copy of the application including specification, claims and drawings must be sent for signature, not just a declaration and assignment. See MPEP 409.03(d).

Regarding item (4), applicant provided an unsigned declaration. However, section 409.03(b) of the MPEP requires petitioner to provide a declaration signed by the 37 CFR 1.47(b) applicant. Hence, item (4) is also not satisfied.

Concerning item (5), section 409.03(f) of the MPEP states, in part:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that:

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

In the instant petition, it is not clear how petitioners are attempting to show that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the above-captioned application. The fact that Lucent Technologies was named as applicant in the underlying international application does not affect their status in the above-captioned national stage application. Petitioner must show their proprietary interest in this application by using one of the three ways listed above. Consequently, item (5) is not satisfied.

Since petitioner failed to meet item(s) (2), (4) and (5) of 37 CFR 1.47(b), it is not appropriate to accept this application under 37 CFR 1.47(b) at this time.

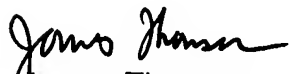
CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the

contents of the letter marked to the attention of the PCT Legal Office.


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